

REMARKS

Program product claims are rewritten to better conform with Requirements of 35 USC 101

Program product claims 15-20 have been cancelled, and rewritten, as new claims 21-26 to better conform to the standards of 35 USC 101 by more clearly defining the state and contribution of the computer program. The new claims 21-26 describe the computer program product as a computer readable medium having a computer readable program stored thereon. The new program product claims replace the original cancelled claims as follows:

<u>Original</u>	<u>New</u>
15	21
16	22
17	23
18	24
19	25
20	26

The Rejection of Claims 1-20 under 35 U.S.C. 103(a) over Kahn et al. (US6,460,038) in view of Kendall et al. (US 2005/0193053), further in view of Burke (US6,032,162), still further in view of Ferguson (6,810,404) is Respectfully Traversed.

All of the claims in the present invention have been rejected as obvious under 35 USC 103(a) based upon the combination of four references. It is a basic principle in Patent Law that a combination of references must be made with the foresight based upon a suggestions coming from the references themselves rather with hindsight based upon Applicants own teaching. The fact that Examiner has had to go to four references has an implication that Examiner has picked and combined selected elements from each of the four

references without foresight coming from the references but rather with hindsight based upon Applicants' own teaching.

It is further submitted, as will be hereinafter shown, that even if the teachings selected from the four references could be combined as suggested by Examiner, the combination would still not render the present claimed invention obvious in view of the combination of references under 35 USC 103.

Review of the Claimed Invention

To review the present claimed invention, Web documents are conventionally presented to the receiving user in a standard all-purpose display interface that serves as a default interface. The user may need to present different types of regularly accessed, i.e. bookmarked, Web documents in different formats. The present invention provides the user at a receiving Web station with a plurality of alternate Web page display interface formats from which the user may select the appropriate format for each Web document that he bookmarks. Thus, each time that a bookmarked Web document will be subsequently displayed, it will have this optimum presentation interface format.

The claimed invention implements the plurality of formats by providing a plurality of folders with each respective document folder associated a corresponding alternate display interface format. The user is enabled to put a bookmarked Web document into a selected document folder associated with an alternate display interface format. Each respective document folder provides each Web document put into the folder with a set of predetermined characteristics and values defining the alternate display interface format.

The Combination of Four References

The combination of the four references; Khan, Kendall, Burke, and Ferguson does not disclose or suggest the combination of elements claimed in the present invention. In order to simplify the issues in this prosecution, Applicants will hereinafter discuss the combination of references and extract what the Examiner and Appellant do agree with respect to each reference and the combination of references.

Kahn

Applicants and Examiner agree that Kahn only teaches the claimed element that received Web documents may be bookmarked.

Kendall

Applicants and Examiner agree that Kendall discloses storing received Web documents in alternate formats. Thus, Applicants and Examiner may be said to agree that the combination of Khan and Kendall discloses that received bookmarked Web documents may be selectively stored by a user in alternate formats.

However, Examiner and Applicants Agree that the Combination of Khan and Kendall Do Not Disclose the Claimed Elements:

".....a document folder associated with each alternate display interface format, said document folder providing each Web document put into said folder with a set of predetermined characteristics and values defining said alternate display interface format;

means, responsive to said bookmarking means, for enabling a user to put a bookmarked Web document into a document folder associated with an alternate display interface format; and

means for displaying bookmarked documents in said document folder in said alternate display interface format."

Burke

The Examiner looks to the Burke patent to make up for these deficiencies in his combination of Kahn and Kendall. Applicants take issue with Examiner and submit that the combination with Burke fails to render the claimed invention obvious for the following reasons.

- The Examiner's combination of Khan and Kendall with Burke is not made with the required foresight based upon a suggestion coming from the references themselves but rather with hindsight based upon Applicants own teaching. Such hindsight does not provide a proper basis for a combination of references.

- Even if the proposed combination with Burke could be made, there would still not be a teaching of the invention because, if anything, the teaching of Burke leads away from the present invention.

There is nothing in either Khan or Kendall to suggest to one skilled in the art that a user may select an alternate format for a received Web document by putting the received Web document into a folder which would provide the selected alternate format. Neither of these two basic references indicates any function related to folders. Applicants fail to find a mention of folders in either Kahn or Kendall for any purpose. Thus, the only suggestion that Examiner look to Burke must have come from Applicants' own teaching.

However, even if Burke were to be combined with the basic references, there would still not be a teaching of the present invention. Burke discloses a facility for the organization and storage of a user's (subscriber's)

bookmarks at facility remote from the user. Burke's facility is intended to organize and categorize the bookmarks and store the bookmarks in files and folders in many categories based upon a wide variety of bookmark attributes, e.g. mainly on themes and topics but including display attributes.

However, it is important to note that in col 5, lines 26-28, Burke states that the file or folder selected for the bookmark is sorted based upon:

"....by an attribute previously allocated to the bookmarks by controller 30 in terminal 10." (underlining added)

This is a critical distinction because in the present claimed invention the display attributes of the Web document results from putting the bookmarked page or document into the folder i.e. the placement of the page into the folder will result in the allocation of the alternate display attributes to the page.

All Burke discloses is assigning a bookmarked document to a folder based upon previously allocated i.e. already existing attributes. The placement of the document into the folder in Burke does not cause the display attributes as in the present claimed invention. Accordingly, Examiner (commencing with last two lines on page 5, Official Action) and Applicants agree that the combination of Kahn, Kebdall, and Burke still does not disclose:

"a document folder associated with each alternate display format, said folder providing each Web document put into said folder with a set of predetermined characteristics and values defining said alternate display interface format."

Ferguson

Examiner looks to this final of the four references to make up for the above deficiency in the three references. However, Ferguson does not teach any element of this invention which has not already been disclosed by Burke. Like Burke, all Ferguson discloses is assigning a bookmarked document i.e. in the form of an STG file to a folder based upon previously allocated i.e. already existing attributes of the STG document file. The placement of the STG document file into a folder in Ferguson does has no affect whatsoever on the attributes of the document file, and certainly does not cause the document to take on any display attributes as claimed by the present claimed invention.

A complete reading of Ferguson makes this deficiency in the Ferguson disclosure very clear. For example, in Ferguson:

- Col. 4, lines 60-65 sets forth that one STG data storage file is created for each new or modified document.
- Col. 6, lines 40-45 sets forth that one such STG file is created for each bookmarked document.
- Col. 7, lines 14-24 sets forth that the Ferguson's "smart" folders are organized so that each folder has defined criteria for the STG document files to be placed into the folder. The smart folders in Ferguson then search for STG document files which already have the criteria or attributes required for the document to be put or linked into the folder. Thus, like Burke, all Ferguson discloses is assigning a bookmarked document i.e. in the form of an STG document file to a folder based upon previously allocated i.e. already existing attributes of the STG document file.

In trying to find support for his interpretation of the teaching of Ferguson, Examiner cites column 8. However, before we discuss the Examiner's citation in Ferguson, Applicants refer Examiner to the following at column 8, lines, 5-12 of Ferguson where it is again set forth that a smart folder searches for STG document files which have the criteria or attributes required by the smart folder, and the STG documents are assigned to the smart folder based upon the already existing attributes of the document.

Examiner cites column 8, lines 55-65 in Ferguson. This section, when read in the light of the entire Ferguson disclosure, does not suggest changing the displayed format of any STG documents in a smart folder. This section sets forth that the smart folder can perform some administrative tasks with respect to the STG documents in the folder such e-mailing functions. Also included in the administrative tasks by the smart folder is the display of folder updates such as the listing of added or deleted STG documents in the folder. This has nothing to do with the display of the actual documents in the folder.

Finally, Examiner cites column 10, lines 24-29 in Ferguson. Here again, Ferguson reinforces the conclusion that his STG documents are placed into folders based upon the existing attributes of the documents, and the folders have no effect whatsoever on any document attributes.

In view of the foregoing, it is submitted that in order to argue that the present claimed invention is obvious, Examiner has combined the Kahn, Kendall, Burke, and Ferguson not in the light of what would have been obvious with the foresight of one skilled of the art, but rather with hindsight based upon Applicants' own teaching. This is not a valid basis for an obviousness rejection under 35 USC 103.

It is submitted that Examiner has used the present Applications' disclosure as a guideline, and then picked and combined elements from each of the four respective references based solely of Applicants' own teaching.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore, 721 F 2d at 1553, 220 USPQ, pp. 312-313.

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 5 USPQ 2d 1596 (C.A.F.C.) 1988.

Accordingly, it is submitted that the suggestion for combining the four references: Kahn, Kendall, Burke and Ferguson in the manner proposed by the Examiner could only be based, with hindsight on Applicants' own teaching, and, thus, cannot provide any valid basis for a combination of references in a rejection under 35 USC 103 based upon obviousness.

It is further submitted that even if the teaching of the four references could be combined, the combination would still not suggest the claimed invention because both the modifying Burke and Ferguson references each fail to suggest a folder providing each Web document put into said folder with a set of predetermined characteristics and values defining said alternate display interface format.

All Burke, and Ferguson disclose is assigning a document to a folder based upon previously allocated i.e. already existing attributes of the document.

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In view of the forgoing, it is submitted that claims 1-20 are in condition for allowance, and such allowance is respectfully requested.

Respectfully submitted,

J.B. Kraft 02/19/08
J. B. Kraft
Attorney for Applicants
Registration No. 19,226
(512) 473-2303

PLEASE MAIL ALL CORRESPONDENCE TO:
Diana Roberts-Gerhardt
IPLaw Dept.
IBM Corporation
11400 Burnet Road
Austin, Texas 78758